REMARKS/ARGUMENTS

This amendment is filed in response to the Final Office Action mailed November 8, 2006. In this Amendment, claims 1, 2, 21, 22 and 38 are amended. Claims 30-37 were previously withdrawn from consideration. Following entry of this amendment, claims 1-29, 38 and 39 shall be pending.

In the Final Office Action, claims 1-29, 38 and 39 have been rejected based on various grounds. The applicant hereby requests reconsideration of these claims in view of the amendments and reasons set forth below.

I. REJECTIONS UNDER 35 USC § 112, FIRST PARAGRAPH

Claims 1-29, 38 and 39 are rejected under 35 USC §112, first paragraph as failing to comply with the written description requirement. Specifically, the Examiner states that Applicant needs to point out where in the specification support exists for the photochromic insert having only one functional layer.

Applicant submits that such support is found throughout the application, including the specifications, the examples and the figures. For example, in the specification at least at paragraphs [0015], [0021], [0023], [0031], [0036]-[0038], [0042], [0045]-[0046], and in each and every one of the examples, only one functional layer is disclosed.

Additionally, all of the Figures describing the present invention clearly disclose only one functional layer. For example, at paragraph [0031], Figure 2 is described as showing "a polyurethane layer 14...and two transparent resin sheet layers 18, 20. " In fact, there is no teaching or disclosure anywhere in the present application that more than one functional layer is used. As such, Applicant submits the presence of only one functional layer is well supported throughout the application and thus, is clearly not new matter.

In view of the foregoing, Applicant submits that ample support is found in the specification for one functional layer thus, this rejection should be withdrawn.

II. REJECTIONS UNDER 35 USC §103(A) AS BEING UNPATENTABLE OVER EITHER *BHALAKIA ET AL.* '459 OR '446 IN VIEW OF EITHER OF EUROPEAN PATENT APPLICATION 1,162,482 OR *NISHIZAWA ET AL.*

Claims 1-29, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of *Bhalakia et al.* '459 or '446 (hereinafter *Bhalakia*) in view of either of EP 1,162,482 (herein after EP) or *Nishizawa et al.* (hereinafter *Nishizawa*). The Examiner asserts that even if the recited "one functional layer" was not new matter, the claims are still obvious in view of the cited prior art. For the reasons set forth below, Applicant disagrees with the Examiner and continues to traverse the rejection.

First, it is noted that independent claims 1, 21 and 38 have been amended to recite that the polyurethane layer has a thickness within a range of about 5 microns to less than 50 microns. This amendment clarifies and emphasizes what is disclosed in the specification (including the drawings) and the figures in connection with the invention, namely, that a thin polyurethane layer within this thickness range is one of the driving factors in achieving a multi-focal, photochromic lens that has a sharp segment line with no bleeding. And since none of the asserted references disclose a polyurethane layer thickness within this claimed range, the rejection fails at the outset.

Nor would a thickness between about 5 microns and less than 50 microns be obvious from *Bhalakia* and *Nishizawa*. *Bhalakia* not only fails to disclose the recited thickness range (as conceded by the Examiner) but *Bhalakia* does not even identify the problems in achieving a multi-focal photochromic lens with a sharp segment line and no bleeding. And as for *Nishizawa*, this reference isn't even directed to a multifocal lens as claimed, let alone a multi-focal, photochromic lens with a sharp segment line (claims 1 and 21) and no bleeding (claim 38) as claimed.

But even if *Nishizawa* were somehow pertinent to amended claims 1, 21 and 38, it actually teaches away from the claimed thickness range. First, upon reviewing the disclosure of *Nishizawa*, it is clear that *Nishizawa* uses a laminate having a minimum thickness of 65 microns, well outside of the claimed range. This is evidenced by the disclosure of a "minimum" 5 micron adhesive layer, a 10 micron polarization layer and a 50 micron photochromic layer (see paragraphs [0027], [0040] and [0042]). Second, even if one considers the thickness of *Nishizawa*'s photochromic layer in isolation, i.e., apart from the laminate as a whole (as the Examiner has done), it can't be ignored that *Nishizawa* teaches that a layer of less than 50 microns results in color development that is insufficient under irradiation of a UV light and contrast becomes low (see paragraph [0027]).

It is therefore clear that neither *Bhalakia* nor *Nishizawa* either discloses or renders obvious the recited thickness range. Indeed, at a minimum, *Nishizawa* actually teaches away from the claimed invention. Therefore, for at least this reason alone, the rejection must fail.

Finally, there is simply no motivation to combine *Nishizawa* with *Bhalakia* in any event. In this regard, the Examiner is reminded that the present application demonstrates that in order to get a sharp segment line in a multi-focal photochromic lens with no bleeding, a minimal thickness of a single photochromic polyurethane layer is required. The examples clearly demonstrate this. See, e.g., Examples 1 and 2, where the thickness of the single polyurethane layer is 38 microns and 25 microns, respectively. This contrasts dramatically with *Nishizawa*.

First, *Nishizawa* is directed to a laminate with multiple functional layers (e.g., photochromic layer plus polarizing layer plus others). It is not a directed to a single functional layer laminate. Hence, for this reason alone, one of ordinary skill would not look to *Nishizawa* when considering the problems overcome by the presently claimed invention.

Second, *Nishizawa* does not disclose a segmented multi-focal lens (as discussed above) which is what is specifically claimed herein. In other words, *Nishizawa* is not even directed to the specific type of lens of the present invention. Therefore, for this reason too one of ordinary skill looking to solve a problem of obtaining a sharp segment line without bleeding in a multi-focal photochromic lens simply would not turn to *Nishizawa*.

Third, even if *Nishizawa* was directed to a segmented multi-focal lens, one of ordinary skill in the art would appreciate that the laminate disclosed therein has multiple functional layers and thus that it relates to a laminate film that is relatively thick. And as disclosed in *Bhalakia*, an important factor in obtaining an acceptable injection molded lens using a laminate film is the overall thickness of the laminate film. Due to the high pressure and high temperature characteristics of the injection molding process such as discussed in *Bhalakia*, a thicker laminate film means that there is more polymeric material that will be subject movement during injection molding (due to, e.g., melting, plastic deformation, etc.). This means that a thicker laminate film makes the injection molding process more complicated and difficult to control. This is especially so in the case where the person of ordinary skill is seeking to make a lens with a sharp segment line where the laminate film must conform extremely well to the segment line in the mold.

Further, the multiple functional layers in the *Nishizawa* laminate means that there are also multiple adhesive layers. And one of ordinary skill in the art familiar with the process disclosed in *Bhalakia* knows that multiple adhesive layers means a highly increased chance of problems with bleeding of the laminate during the molding process.

Therefore, one of ordinary skill in the art looking to create a multi-focal photochromic lens with a sharp segment line without bleeding would simply NOT look to *Nishizawa*. First, *Nishizawa* is not directed to single functional layer as claimed. Second *Nishizawa* is not directed to a segmented multi-focal photochromic lens as claimed. Third, even if it was directed to a segmented multi-focal photochromic lens,

the multi functional layer laminate of *Nishizawa* would complicate, not simplify, the injection molding process due to the fact the laminate has a greater thickness and multiple adhesive layers. Therefore one of ordinary skill would simply not look to combine the teachings of *Nishizawa* with *Bhalakia* as asserted by the Examiner. Accordingly, even notwithstanding the deficiencies of these two references as noted above, they are not properly combinable in any event.

As such, for all of the above reasons, Applicant respectfully requests withdrawal of the present rejection and submits that independent claims 1, 21 and 38 are now in condition for allowance. Furthermore, claims 2-20, 22-29 and 39 depend from allowable claims 1, 21 and 38 and it is thus submitted that these claims are allowable for at least the same reasons. However, these claims further define and describe the present invention and are patentable over and above claims 1, 21 and 38.

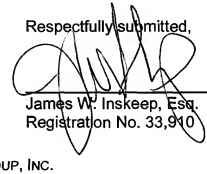
CONCLUSION

In view of the foregoing, it is submitted that currently pending claims 1-29, 38 and 39 are now in condition for allowance. Thus, it is respectfully requested that the Examiner withdraw all of the rejections and issue a notice of allowance of all claims.

If for any reason direct communication with Applicants' attorney would serve to advance prosecution of this case to finality, the Examiner is cordially urged to call the undersigned attorney at the below listed telephone number.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 50-2809.

Respectfully submitted,



Dated: April 9, 2007

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